

Appl. No. : 10/663,381  
Filed : September 15, 2003

## REMARKS

### A. Introduction

Applicants wish to thank the Examiner for the courtesy extended during the telephonic interview conducted on August 23. The agreement that was reached advantageously narrows the issues still under consideration in this application.

Applicants respectfully request reconsideration and allowance of this application. Claims 1-13 and 15-25 are pending in the application. The Examiner has indicated that Claims 7 and 10-12 are allowed. In addition, since the Examiner agreed to withdraw all rejections that are based on any combination of references including Gaylord and Jagdat, Claims 1, 2, 4-6, 8, 9, 13 and 15-22 should also now be allowable, subject to the Examiner's further search of the prior art.

Applicants submit that this application is in condition for allowance, and Applicants earnestly request such action. Below, Applicants address each of the Examiner's reasons for rejection.

### B. All Claims are Patentable Over the Cited References

#### Gaylord in view of Jagdat

The Examiner rejected Claims 1, 2, 4, 8, 15-18 and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,659,971 to Gaylord in view of U.S. Patent No. Des. 317,840 to Jagdat. As explained above, during the telephonic interview conducted on August 23 the Examiner agreed to withdraw these rejections. Accordingly, Applicants respectfully request that the Examiner allow Claims 1, 2, 4, 8, 15-18 and 22.

#### Gaylord and Jagdat in view of Schaefer

The Examiner rejected Claims 5, 6, 13, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Gaylord and Jagdat in view of U.S. Patent No. 4,598,701 to Schaefer. As explained above, during the telephonic interview conducted on August 23 the Examiner agreed to withdraw these rejections. Accordingly, Applicants respectfully request that the Examiner allow Claims 5, 6, 13, 19 and 20.

#### Gaylord in view of Schaefer

The Examiner rejected Claims 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Gaylord in view of Schaefer. Applicants respectfully submit that these claims are allowable over the combination of Gaylord and Schaefer.

Various preferred embodiments of the present application define, *inter alia*, a shoulder sling adapted to support a human wearer's arm at desired angles of abduction and external rotation. The sling comprises a support pillow, a pouch adapted to cooperate with the support pillow lateral surface to at least partially enclose the wearer's forearm, a shoulder pad adapted to rest upon the wearer's shoulder and plurality of straps adapted to secure the support pillow and the pouch to the wearer. The support pillow includes a contoured medial surface adapted to abut the wearer's torso and a lateral surface adapted to support the wearer's forearm. A first one of the straps comprises a torso strap that is adapted to extend around the wearer's torso and keep the medial surface of the support pillow in abutting contact therewith. A second one of the straps comprises a chest strap adapted to support an anterior portion of the support pillow and suspend the anterior portion of the support pillow from an anterior edge of the shoulder pad. A third one of the straps comprises a back strap adapted to support a posterior portion of the support pillow and suspend the posterior portion of the support pillow from a posterior edge of the shoulder pad.

By contrast Gaylord discloses an adjustable abduction apparatus as described above. Contrary to the Examiner's assertion, Gaylord does not disclose or suggest a shoulder sling for supporting a wearer's arm at a desired angle of external rotation. In fact, not only does Gaylord contain no hint of supporting a wearer's arm at a desired angle of external rotation, but the figures illustrate that the shoulder sling is designed to support a wearer's arm at a desired angle of internal rotation. See Figures 2, 6, 7 and 11. Thus, Gaylord teaches away from Applicants' shoulder sling. Where one reference teaches away from the claimed invention, that reference cannot be combined with another reference to establish a *prima facie* showing of obviousness. See M.P.E.P. § 2143.01.

Schaefer also does not disclose or suggest supporting a wearer's arm at a desired angle of external rotation. Since neither Gaylord nor Schaefer discloses or suggests supporting a wearer's arm at a desired angle of external rotation, and Gaylord in fact teaches away from this configuration, the combination of Gaylord and Schaefer cannot disclose or suggest this feature.

Furthermore, neither Gaylord nor Schaefer teaches or suggests a chest strap adapted to support an anterior portion of the support pillow and suspend the anterior portion of the support pillow from an anterior edge of the shoulder pad. And, neither Gaylord nor Schaefer teaches or

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suggests a back strap adapted to support a posterior edge of the shoulder pad. In Gaylord, the removable pad 80 is selectively positionable along the second strap segment 54. (See col. 8, ll. 11-37.) Accordingly, no portion of the cushion 20 is suspended from the removable pad 80. Schaefer does not even disclose or suggest a shoulder pad. Since neither of these references discloses or suggests the chest strap or back strap as described above, their combination similarly cannot disclose these features.

Since neither Gaylord nor Schaefer, nor their combination, teaches or suggests the features described above, Applicants respectfully submit that independent Claim 23 is allowable over Gaylord in view of Schaefer. Dependent Claim 25, which includes the features of independent Claim 23, recites additional features of particular advantage and utility. Moreover, this claim is allowable for substantially the same reasons presented above. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections.

The Examiner has argued that the language "adapted to" did not appear in Applicants' original disclosure, and that the claims containing this language (Claims 23-25) have therefore not been considered on the merits. Applicants respectfully assert that these claims have already been considered on their merits. For example, Claim 23, which recites "adapted to" several times, was rejected as being unpatentable over Gaylord in view of Schaefer. Clearly this claim has been considered on its merits. Accordingly, Applicants respectfully request that the Examiner consider the patentability arguments set forth herein pertaining to Claims 23-25, and withdraw all rejections of these claims.

Gaylord and Jagdat in view of Bastyr

The Examiner rejected Claims 9 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Gaylord and Jagdat in view of U.S. Patent No. 5,407,420 to Bastyr. As explained above, during the telephonic interview conducted on August 23 the Examiner agreed to withdraw these rejections. Accordingly, Applicants respectfully request that the Examiner allow Claims 9 and 21.

Gaylord and Schaefer in view of Bastyr

The Examiner rejected Claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Gaylord and Schaefer in view of Bastyr. Applicants respectfully submit that this claim is allowable over the combination of Gaylord, Schaefer and Bastyr.

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Claim 24 depends from Claim 23, the allowability of which Applicants have demonstrated above. Since Claim 24 includes all of the limitations of Claim 23, it is allowable for the same reasons presented above. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

### CONCLUSION

For the reasons presented above, Applicants respectfully submit that this application is in condition for allowance. If there is any further hindrance to allowance of the pending claims, Applicants invite the Examiner to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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